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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,929	08/31/2001	Renee E. Dye	026592.113-US00	8947

26853 7590 03/09/2005

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WASHINGTON, DC 20004-2401

EXAMINER

THAI, CANG G

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,929	DYE ET AL.	
	Examiner	Art Unit	
	Cang G. Thai	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 31, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>August 31, 2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 08/31/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 24-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. whether the invention is within the technological arts; and
2. whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

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In the present case, Claim 24 is directed to "a method for facilitating the development of strategic options comprising:

requesting information comprising descriptions of strategic options;

receiving the information;

storing the information;

organizing the information into a list of strategic options;

displaying the list of strategic options;

requesting a selection of a strategic option from the list;

receiving the selection; and

for the selected strategic option, requesting information responsive to predetermined implementation criteria".

In the present case, Claim 24 does not require any technology. The recited steps for facilitating the development of strategic options does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea of how to facilitate the development of strategic options.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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5. Claims 1-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites "system". The preamble mentions the term "system", which normally means "any collection of component elements that work together to perform a task. Examples are a hardware system consisting of a microprocessor, its allied chips and circuitry, input and output devices, and peripheral devices; an operating system consisting of a set of programs and data files, or a database management system used to process specific kinds of information", but there is no step of "a database management system used to process specific kinds of information" in the system. It appears that they should be related, but no positive language showing the relationship has been shown.

Claim 24, recites "storing" and "displaying". In the body of the claim mentions the term "storing" which normally means "to place or leave in a location (as a warehouse, library, or computer memory) for preservation or later use or disposal", but there is no step of "computer memory" for storing the information. Also, in the body of the claim mentions the term "displaying" which normally means "the visual out put device of a computer, which is commonly a CRT-based video display, but there is no step of a computer for displaying the list of strategic options. It is not clear on the relationship of the term "strategic option" in steps. It appears that they should be related, but no positive language showing the relationship has been shown.

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Claim 35, recites "computer-readable". The preamble mentions the term "computer-readable" which normally means "of, pertaining to, or characteristic of information that can be interpreted and acted on by a computer. Two types of information are referred to as computer readable: bar codes, magnetic tape, magnetic-ink characters, and other formats that can be scanned in some way and read as data by a computer; and machine code, the form in which instructions and data reach the computer's microprocessor", but there is no step of "characteristic of information" in order to be acted by a computer. It appears that they should be related, but no positive language showing the relationship has been shown.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-60 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. US 6,115,691 (ULWICK).

As for claim 1, ULWICK discloses a system for facilitating the development of strategic options comprising:

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a processor, comprising a memory device, connected to a display device and an input device {See Fig. 15, Element 106}, wherein

the display device displays a request-prompt requesting information comprising descriptions of strategic options {See Fig. 15, Element 108};

the input device receives information responsive to the request-prompt {See Fig. 15, Element 102};

the memory device stores the information received by the input device {See Fig. 15, Element 104};

the processor organizes the information into a list of strategic options {See Fig. 15, Element 106};

the display device displays the list and a selection-prompt requesting a selection of a strategic option {See Fig. 15, Element 21};

the input device receives the selection {See Fig. 15, Element 22}, and

the display device displays an implementation-prompt requesting, for the selected strategic option, information responsive to predetermined implementation criteria {See Fig. 15, Element 23}.

As for claim 2, ULWICK discloses the system of claim 1, wherein the request-prompt comprises a description of an approach to strategic option development {See Fig. 15, Element 24}.

As for claim 3, ULWICK discloses the system of claim 2, wherein the request-prompt further comprises an example strategy exemplifying the approach to strategic option development {See Fig. 15, Element 25}.

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As for claim 4, ULWICK discloses the system of claim 1, wherein the request-prompt comprises a description of a trend {See Fig. 15, Element 26}.

As for claim 5, ULWICK discloses the system of claim 4, wherein the request-prompt further comprises an example strategy responsive to the trend {See Fig. 15, Element 27}.

As for claim 6, ULWICK discloses a system for facilitating the development of strategic options comprising:

a processor, comprising a memory device, connected to a display device and an input device {See Fig. 15, Element 106}, wherein

the display device displays an exercise list identifying a plurality of strategic option exercises and solicits a selection of a strategic option exercise {See Fig. 15, Element 108};

the input device receives the selection of the strategic option exercise {See Fig. 15, Element 102};

the display device displays a request-prompt associated with the selected strategic option exercise, wherein the request-prompt requests information comprising descriptions of strategic options {See Fig. 15, Element 108};

the input device receives information responsive to the request-prompt {See Fig. 15, Element 102};

the memory device stores the information responsive to the request-prompt received by the input device {See Fig. 15, Element 104};

the processor organizes the information responsive to the request-prompt into a list of strategic options {See Fig. 15, Element 106};

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the display device displays the list of strategic options and a selection-prompt requesting a selection of a strategic option {See Fig. 15, Element 108};

the input device receives the selection of the strategic option {See Fig. 15, Element 102}; and

the display device displays an implementation-prompt requesting, for the selected strategic option, information responsive to predetermined implementation criteria {See Fig. 15, Element 108}.

As for claim 7, ULWICK discloses the system of claim 6, wherein the request-prompt comprises a description of an approach to strategic option development {See Fig. 7, Element 7}.

As for claim 8, ULWICK discloses the system of claim 7, wherein the request-prompt further comprises an example strategy exemplifying the approach to strategic option development {See Fig. 8, Element 8}.

As for claim 9, ULWICK discloses the system of claim 6, wherein the request-prompt comprises a description of a trend {See Fig. 9, Element 9}.

As for claim 10, ULWICK discloses the system of claim 9, wherein the request-prompt further comprises an example strategy responsive to the trend {See Fig. 10, Element 10}.

As for claim 11, ULWICK discloses the system of claim 6, wherein the display device solicits the selection of a second strategic option exercise {See Fig. 11, Element 11};

the input device receives the selection of the second strategic option exercise {See Fig. 12, Element 12};

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the display device displays a second request-prompt associated with the selected second strategic option exercise, wherein the second request-prompt requests information comprising descriptions of strategic options {See Fig. 12, Element 12};

the input device receives information responsive to the second request-prompt {See Fig. 12, Element 12};

the memory device stores the information responsive to the second request-prompt received by the input device {See Fig. 14, Element 104}; and

the processor organizes the information responsive to the second request-prompt into the list of strategic options {See Fig. 14, Element 106}.

As for claim 12, which has the same limitations as in claim 6, therefore, it is rejected for the similar reasons set forth in claim 6.

As for claim 13, which has the same limitation as in claim 7, therefore, it is rejected for the similar reason set forth in claim 7.

As for claim 14, which has the same limitation as in claim 8, therefore, it is rejected for the similar reason set forth in claim 8.

As for claim 15, which has the same limitation as in claim 9, therefore, it is rejected for the similar reason set forth in claim 9.

As for claim 16, which has the same limitation as in claim 10, therefore, it is rejected for the similar reason set forth in claim 10.

As for claim 17, ULWICK discloses the system of claim 12, wherein the first, second, and third display means are the same means {See Fig. 15, Element 108}.

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As for claim 18, which has the same limitations as in claim 6, therefore, it is rejected for the similar reasons set forth in claim 6.

As for claim 19, which has the same limitation as in claim 7, therefore, it is rejected for the similar reason set forth in claim 7.

As for claim 20, which has the same limitation as in claim 8, therefore, it is rejected for the similar reason set forth in claim 8.

As for claim 21, which has the same limitation as in claim 9, therefore, it is rejected for the similar reason set forth in claim 9.

As for claim 22, which has the same limitation as in claim 10, therefore, it is rejected for the similar reason set forth in claim 10.

As for claim 23, ULWICK discloses the system of claim 18, wherein the first, second, third, and fourth display means are the same means {See Fig. 15, Element 105}.

As for claim 24, ULWICK discloses a method for facilitating the development of strategic options comprising:

requesting information comprising descriptions of strategic options {Column 1, Lines 43-44, wherein this reads over "by loading mission specific data into the input module"};

receiving the information {Column 1, Lines 48-49, wherein this reads over "the data is manipulated by the software invention is compiled"};

storing the information {Column 1, Lines 58-60, wherein this reads over "the memory locations comprise a plurality of identifiable data storage array locations that are indexed by the processor"};

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organizing the information into a list of strategic options {Column 1, Lines 55-58, wherein this reads over “the facts are collected in advance and structured for each specific mission, loaded into the computer, or processor means, stored in predetermined memory locations, and processed by the software”};

displaying the list of strategic options {See Fig. 5, Element 5};

requesting a selection of a strategic option from the list {See Fig. 6, Element 6};

receiving the selection {See Fig. 7, Element 7}; and

for the selected strategic option, requesting information responsive to predetermined implementation criteria {See Fig. 10, Element 10}.

As for claim 25, ULWICK discloses the method of claim 24, further comprising displaying a prompt describing an approach to strategic option development {Column 7, Lines 23-25, wherein this reads over “the user is presented with the criteria by which they may evaluate all potential solutions to achieve the desired outcomes”}.

As for claim 26, ULWICK discloses the method of claim 25, wherein the prompt comprises an example strategy exemplifying the approach to strategic option development {Column 7, Lines 54-57, wherein this reads over “presenting the user with predetermined facts and values to make decisions eliminates decisions being made by subjective criteria, such as gut feel, intuition, or self-serving motivations”}.

As for claim 27, ULWICK discloses the method of claim 24, further comprising displaying a prompt comprising a description of a trend {Column 7,

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Lines 57-59, wherein this reads over “decisions that were once made subjectively can now be made objectively and logically”}.

As for claim 28, ULWICK discloses the method of claim 27, wherein the prompt further comprises an example strategy responsive to the trend {Column 7, Lines 59-62, wherein this reads over “it is for this reason that solutions derived using this invention can deliver many more times the value to the target customer segments than those solutions derived using traditional methods”}.

As for claim 29, ULWICK discloses a method for facilitating the development of strategic options comprising:

displaying an exercise list identifying a plurality of strategic option exercises {See Fig. 3, Element 3};

soliciting a selection of a strategic option exercise from the exercise list {See Fig. 4, Element 4};

receiving the selection of the strategic option exercise {See Fig. 5, Element 5};

displaying a request-prompt associated with the selected strategic option exercise {See Fig. 6, Element 6},

wherein the request-prompt requests information comprising descriptions of strategic options {See Fig. 8, Element 8};

receiving information responsive to the request-prompt {See Fig. 9, Element 9};

organizing the information responsive to the request-prompt into a list of strategies options {See Fig. 10, Element 10};

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displaying the list of strategic options {See Fig. 11, Element 11};
displaying a selection-prompt for a selection of a strategic option {See Fig. 12, Element 12};
receiving the selected strategic option {See Fig. 13, Element 13}; and
for the selected strategic option, requesting information responsive to predetermined implementation criteria {See Fig. 15, Element 34}.

As for claim 30, ULWICK discloses the method of claim 29, wherein the request-prompt comprises a description of an approach to strategic option development {See Fig. 15, Element 22}.

As for claim 31, ULWICK discloses the method of claim 30, wherein the request-prompt further comprises an example strategy exemplifying the approach to strategic option development {See Fig. 15, Element 23}.

As for claim 32, ULWICK discloses the method of claim 29, wherein the request-prompt comprises a description of a trend {See Fig. 15, Element 24}.

As for claim 33, ULWICK discloses the method of claim 32, wherein the request-prompt further comprises an example strategy responsive to the trend {See Fig. 15, Element 25}.

As for claim 34, which has the same limitations as in claim 29, therefore, it is rejected for the similar reasons set forth in claim 29.

As for claim 35, which has the same limitations as in claim 1, therefore, it is rejected for the similar reasons set forth in claim 1.

As for claim 36, which has the same limitation as in claim 2, therefore, it is rejected for the similar reason set forth in claim 2.

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As for claim 37, which has the same limitation as in claim 3, therefore, it is rejected for the similar reason set forth in claim 3.

As for claim 38, which has the same limitation as in claim 4, therefore, it is rejected for the similar reason set forth in claim 4.

As for claim 39, which has the same limitation as in claim 5, therefore, it is rejected for the similar reason set forth in claim 5.

As for claim 40, which has the same limitations as in claim 6, therefore, it is rejected for the similar reasons set forth in claim 6.

As for claim 41, which has the same limitation as in claim 7, therefore, it is rejected for the similar reason set forth in claim 7.

As for claim 42, which has the same limitation as in claim 8, therefore, it is rejected for the similar reason set forth in claim 8.

As for claim 43, which has the same limitation as in claim 9, therefore, it is rejected for the similar reason set forth in claim 9.

As for claim 44, which has the same limitation as in claim 10, therefore, it is rejected for the similar reason set forth in claim 10.

As for claim 45, which has the same limitation as in claim 11, therefore, it is rejected for the similar reason set forth in claim 11.

As for claim 46, which has the same limitations as in claims 1 and 6, respectively, therefore, it is rejected for the similar reasons set forth in claims 1 and 6, respectively.

As for claim 47, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by challenging widely held beliefs {See Fig. 2, Element 2}.

As for claim 48, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying an analogy; and the request-prompt requests descriptions of strategic options responsive to the analogy {See Fig. 5, Element 5}.

As for claim 49, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying a discontinuity; and the request-prompt requests descriptions of strategic options responsive to the discontinuity {See Fig. 8, Element 8}.

As for claim 50, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by altering a metric; and the request-prompt requests descriptions of strategic options responsive to the altered metric {See Fig. 7, Element 7}.

As for claim 51, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying a constraint; and the request-prompt requests descriptions of strategic options responsive to exceeding the constraint {See Fig. 8, Element 8}.

As for claim 52, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying an extreme implementation of a business, and the request-prompt requests

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descriptions of strategic options responsive to the extreme implementation {See Fig. 10, Element 10}.

As for claim 53, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying a capability of a business; and the request-prompt requests descriptions of strategic options responsive to the capability {See Fig. 11, Element 11}.

As for claim 54, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying a use of a first product; and the request-prompt requests descriptions of strategic options, wherein the strategic options comprise descriptions of an alternate product substantially serving the use of the first product {See Fig. 12, Element 12}.

As for claim 55, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic option by identifying a conventionally recognized limit {See Fig. 13, Elements 13}.

As for claim 56, ULWICK discloses the system of claim 46, wherein the exercise explanation describes developing strategic options by identifying a limit placed on a business by a legacy; and the request-prompt requests descriptions of strategic options responsive exceeding the limit {See Fig. 15, Element 38}.

As for claims 57, 58 & 59, which have the same limitation as in claim 48, therefore, it is rejected for the similar reason set forth in claim 48.

As for claim 60, which has the same limitation as in claim 55, therefore, it is rejected for the similar reason set forth in claim 55.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent No. 6,546,545 (HONAVAR ET AL.) is cited to teach decision management system which provides strategy versioning,
- 2) U.S. Patent No. 5,153,830 (FISHER ET AL.) is cited to teach creativity and problem solving to help speed up the creative process using an interactive database, and
- 3) U.S. Patent Application Publication No. 2002/0147627 (ROOSEVELT ET AL.) is cited to teach a conceptual design for a product or service involves defining conceptual design project goals and parameters and the creating a project team representing several diverse types of intelligences.

II. Foreign Patent:

- 1) JP 2001056763 A (ISHINO, YOKO) is cited to teach a product concept to be a policy in the case of developing a product.

III. Non-Patent Literature:

- 1) SERAFIN D. TALISAYON, "BUSINESSWORLD (PHILIPPINES): Knowledge and People: Creating knowledge", March 13, 2001, BusinessWorld, Manila, Page 1.

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- 2) Ayres and Steger, "Rejuvenating the life cycle concept", Summer 1985, Journal of Business Strategy (pre-1986), ABI/INFORM Global, Page 67.
- 3) Menon, Gharadwaj, Adidam & Edison, "Antecedents and Consequences of Marketing Strategy Making: A Model and a Test", April 1999, Journal of Marketing, ABI/INFORM Global, Page 18.
- 4) Christian N. Madu, "A Decision Support Framework for Environmental Planning in Developing Countries", May 1999, Journal of Environmental Planning and Management, ABI/INFORM Global, Page 287.

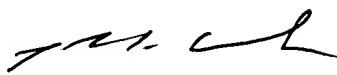
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (703) 305-0553. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
3/4/2005



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